

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

| | | |
|---------------------------------------------------|---|----------------------------|
| In re Application of | : | Customer Number: 46321 |
| | : | |
| William C. BARLOW | : | Confirmation Number: 7207 |
| | : | |
| Application No.: 10/788,860 | : | Group Art Unit: 2444 |
| | : | |
| Filed: February 27, 2004 | : | Examiner: Muktesh G. Gupta |
| | : | |
| For: POLICY BASED PROVISIONING OF WEB CONFERENCES | | |

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated April 13, 2010. The Examiner's response to Appellants' arguments submitted in the Supplemental Appeal Brief of January 19, 2010, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Supplemental Appeal Brief of January 19, 2010, and the arguments set forth below.

REMARKS

Rejection of claims 1, 4 and 6-7 under 35 U.S.C. § 101

As indicated on page 2, Section IV of the Supplemental Appeal Brief, in an Amendment under 37 CFR § 1.116 dated July 24, 2009, the Appellants amended independent claims 1 and 8 to recited structural features to overcome the rejection under 35 U.S.C. § 101. In a telephone conference on August 31, 2009, the Examiner acknowledged that Applicant's Reply overcomes the 35 U.S.C. § 101 rejections and entered the amendments to independent claims 1 and 8.

On page 2, section IV, Status of Amendments, of the Examiner's Answer, the Examiner confirms "Appellant's statement of the status of amendments after final rejection contained in the brief is correct." However, on page 38 of the Examiner's Answer, the Examiner appears to renege on the agreement and states "For purpose of Appeal, the proposed amendment will not be entered." Appellant is confused by this statement and request this Honorable Board to consider the Claims as amended in the Amendment under 37 CFR § 1.116 dated July 24, 2009 and as provided in the Section VIII, Claims Appendix on page 19 of the Supplemental Appeals Brief.

Rejection of claim 1 under 35 U.S.C. § 103

Appellant has compared the statement of the rejection found on pages 4-33 of the Examiner's Answer with the statement of the rejection found on pages 11-44 of the Fourth Office Action. Upon making this comparison, Appellant has been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellant proceeds on the basis that the Examiner's sole response to Appellant's Appeal Brief is found on pages 34-41 of the Examiner's Answer.

The overarching issue at hand is whether Gudjonsson identically discloses a policy manager that processes a policy set forth in a policy document and processes a request for a Web conferencing from a communicatively linked end user to select one of the Web conferencing platforms to host said Web conference. The two sub-issues are (i) whether Gudjonsson *explicitly*, identically discloses the claimed limitations at issue and (ii) whether Gudjonsson *inherently*, identically discloses the claimed limitations at issue. For the reasons presented on page 9, line 8 through page 11, line 18 of the Appeal Brief, Appellant's position is that Gudjonsson neither explicitly nor inherently identically discloses the claimed limitations at issue.

1
2 In the first paragraph on page 36 of the Examiner's Answer, the Examiner
3 asserted the following:

4 Examiner considers Cluster operator as a Manager, which implements
5 various policies for controlling managing and administrating various services,
6 such as Video Conferencing, Web conferencing. Cluster operator is positioned
7 between users and back end services running on various platforms and
8 implements policies through administration tools for managing, controlling and
9 monitoring user accounts, profiles, billing policies, security, authentication and
10 permission for various services as and when user request for services after
11 conforming to the user administration data stored in database, in other words
12 implementing policies from policy document. (emphasis added)
13

14 Although the Examiner's asserts that "in other words implementing policies from
15 policy document" this is a conclusory statement that is not supported by the cited
16 passages of Gudjonsson. In fact, as previously argued, there is no mention of a
17 policy contain with a policy document in Gudjonsson.
18

19 Additionally, the claimed invention refers to the policy manager processing
20 a request for a Web conferencing. The teachings of Gudjonsson, however, do not
21 refer to a "request for Web conferencing". Instead, the Examiner refers to an
22 "invitation" on page 14 of the Examiner's Answer and states:

23 The system/network handles the initial discovery of the mutual
24 communication channel using "invitations." An invitation is basically a request

1 from one user 7 to another to join him/her in some given type of communication.

2 When a user 7 wishes to establish a communication with another user, he/she will
3 invoke some function within his/her client 11, requesting the client to send an
4 invitation of a given type to some selected user. (emphasis original)
5

6 Unlike the “invitation” of Gudjonsson, the “request” recited in claim 1 is a sent by
7 a user to the policy manager requesting the policy manager to select a Web
8 conferencing platform to host a Web conference. Thus, the teachings of
9 Gudjonsson do not refer to a request that is processed by the policy manager.
10 Therefore, for the above-identified reasons, Appellant respectfully submits that the
11 Examiner has committed reversible error by failing to properly ascertain the
12 differences between Gudjonsson and the claimed limitations. Thus, the Examiner
13 has committed error by ignoring certain of the claimed limitations when making the
14 Graham findings of fact. Thus, the Examiner's analysis is predicated upon an
15 improper claim construction, and, therefore, the Examiner has committed
16 reversible error.
17

18 With regard to the secondary reference of Nguyen, on page 18 of the Fourth
19 Office Action, the Examiner asserted the following:

20 *Accordingly it would have been obvious to one of ordinary skill in the networking*
21 *art at the time of the invention to modify Gudjonsson's Cluster Operator using the*
22 *user management functions (implementing policies), security, and authentication*
23 *and charging features (billing policies) of the system/network as base for*

1 *providing Web conferencing services, to that of Nguyen's from the same field*
2 *networking art discloses Internet service provider Architecture which provides*
3 *configuration guidelines in its implementation of providing services on one or*
4 *more of an operating platform, an operating environment, and one or more*
5 *services where resource manager may provide the ability to control and allocate*
6 *one or more of, resources, services and systems are preferably easier to manage*
7 *because of the ability to set and enforce policies that control how system*
8 *resources are utilized, preferably ensuring that customers will receive the*
9 *assigned service level within a shared resource environment).*

10
11 At the outset, Appellant notes that the Examiner is employing circular logic. In
12 essence, the Examiner is asserting that it would have been obvious to use the
13 configuration guidelines feature in Nguyen with Gudjonsson's Cluster Operator
14 because "services and systems are preferably easier to manage because of the ability
15 to set and enforce policies that control how system resources are utilized,
16 preferably ensuring that customers will receive the assigned service level within
17 a shared resource environment." Put differently, the Examiner is asserting that it
18 would have been obvious to include B into A for the purpose of providing B.

19
20 If such circular reasoning was permissible in establishing obviousness, then
21 few patents would ever issue. As recognized by the Federal Circuit, "virtually all
22 [inventions] are combinations of old elements."¹ Thus, every element of a claimed
23 invention may often be found in the prior art. If stating that it would have been

¹ In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

1 obvious to include B into A for the purpose of providing B, then all combinations
2 would be obvious. This analysis, however, does not accurately reflect obviousness
3 jurisprudence. As stated by the Supreme Court, “rejections on obviousness grounds
4 ... must [based upon] some articulated reasoning with some rational underpinning
5 to support the legal conclusion of obviousness.” The Examiner's circular
6 reasoning, however, falls short of this requirement.

7
8 However, even *assuming arguendo* that it would have been obvious to
9 combine the teachings of Gudjonsson and Nguyen for the benefits described by the
10 Examiner, the Examiner has failed to establish that the resultant combination
11 would have rendered the claimed invention as obvious within the meaning of 35
12 U.S.C. § 103. Although the Examiner may have shown that it would have been
13 obvious to add the teachings of Nguyen to the teachings of Gudjonsson, the
14 Examiner has not established it would have been obvious to modify the teachings
15 of Gudjonsson based upon the teachings of Nguyen.

16
17 Adding, configuration guidelines feature, as taught by Nguyen, to the
18 network of server clusters of Gudjonsson would result in the benefits associated
19 with these teachings without any modifications to the teachings of Gudjonsson.
20 Since these functions are independent, there is no need to modify one teaching

(i.e., Gudjonsson) with the other (i.e., Nguyen) to obtain the benefits of both. Therefore, Appellants respectfully submit that even if one having ordinary skill in the art would have found combining a configuration guidelines feature of Nguyen with the teachings of Gudjonsson to be obvious, the combination of these teachings would not result in the claimed invention. Additionally, Appellants also note that the Examiner has not even explained how Gudjonsson could be modified in view of Nguyen to result in the claimed invention.

Claim 2

The Examiner did not respond to Appellant's arguments as to dependent claim 2.

For the reasons set forth in the Supplemental Appeal Brief of January 19, 2010, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 122158, and please credit any excess fees to such deposit account.

Date: June 14, 2010

Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg

Registration No. 44,725

Adam C. Underwood

Registration No. 45,169

Carey Rodriguez Greenberg Paul

950 Peninsula Corporate Circle

Suite 2022

Boca Raton, FL 33487

Phone: (561) 922-3845

Fax: (561) 244-1062

CUSTOMER NUMBER 46521